

Jonathan A. Bard, et al.
Serial No.: 09/430,775
Filed: October 29, 1999
Page 11

REMARKS

Claims 147-153 were pending in the subject application, and claims 149 and 150 were withdrawn from consideration. By this Amendment, applicants have canceled claims 149, 150, 151 and 152. Accordingly, upon entry of this Amendment, claims 147, 148 and 153, will be pending and under examination.

Applicants maintain that the amendments to the specification and the claims raise no issue of new matter. The specification has been amended to correct continuing application data, the labeling of the drawings, the format of sequence identifiers and the address of the American Type Culture Collection.

Support for the amendments to claims 147 and 148 may be found inter alia in the specification, as originally-filed, on page 15, lines 9-14; page 15, lines 24-25; page 11, lines 4-16; and page 19, lines 16-33. Support for the amendments to claim 153 may be found inter alia in the specification, as originally-filed, on page 28, lines 1-8.

Accordingly, applicants respectfully request that the Amendment be entered.

Restriction Requirement

On page 2 of the November 21, 2003 Office Action, the Examiner acknowledged applicant's election with traverse of Group I, however the Examiner alleged that the inventions are distinct from each other. The Examiner alleged that the methods of inventions I-III are independent, use separate method steps

and have different effects. The Examiner further alleged that a search of Groups I-III would not be co-extensive particularly with regard to the literature search. The Examiner alleged that an examination of the materially different, patentably distinct inventions would constitute a serious burden on the Examiner. The Examiner withdrew claims 149-150 from further consideration (37 CFR 1.142(b)), and made the requirement final.

Objections to the Disclosure

On page 3 of the November 21, 2003 Office Action, the Examiner objected to the disclosure because of the following informalities: (1) The Examiner alleged that the disclosure must contain proper information relating to the parent application and that the priority information must be recited in the first sentence of the specification; (2) The Examiner also required the heading "Brief Description of the Figures" be changed to recite "Brief Description of the Drawings"; (3) The Examiner requested that the Figure labels be corrected and a new set of drawings be submitted within the time period set in the Office Action. Also the Figures must be correctly described in the Brief Description of the Drawings; (4) The Examiner requested that nucleotide sequences be identified with sequence identifiers on page 52, lines 24-25, and throughout the specification. 5) Finally, the Examiner requested that the specification reflect the correct ATCC address.

In response, in an attempt to advance the prosecution but without conceding either the need for amendment or the

Jonathan A. Bard, et al.
Serial No.: 09/430,775
Filed: October 29, 1999
Page 13

correctness of the Examiner's position, applicants have made the appropriate corrections to the specification and drawings. Applicants respectfully point out that several amendments to add appropriate sequence identifiers on pages 11, 12, 45, 46, and 52 were submitted previously in the Preliminary Amendment filed on October 29, 1999.

In light of the amendments to the specification and drawings, applicants respectfully request that the objections be withdrawn.

Rejections Under 35 U.S.C. §112, Second Paragraph

On page 5 of the November 21, 2003 Office Action, the Examiner rejected claims 147-148 and 151-153, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner alleged that claims 147-148 are indefinite because the name human Y4 receptor does not provide any structural limitation on the claim and the metes and bounds of the claim cannot be determined. The Examiner then alleged that it is unclear what is a Y4 receptor. The Examiner then suggested that the human Y4 receptor be identified by SEQ ID NO.

The Examiner also rejected claim 151 because the term "substantially" is allegedly a relative term which renders the claim indefinite.

The Examiner then rejected claims 151, 152 and 153 for allegedly being dependent upon non-elected claims 149 and 150 and suggested that dependency be amended. The Examiner further rejected claims 151-153 for allegedly being dependent upon an indefinite base claim.

In response, in an attempt to advance the prosecution but without conceding either the need for amendment or the correctness of the Examiner's position, applicants have amended claims 147, 148 and 153; and canceled claims 151 and 152. Applicants maintain that claims 147 and 148, as amended, clearly define the human Y4 receptor. Applicants also maintain that claim 153 is no longer dependent upon non-elected or indefinite claims.

Accordingly, applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. §112, second paragraph.

Rejections Under 35 U.S.C. §112 first paragraph

On page 6 of the November 21, 2003 Office Action, the Examiner rejected claims 147-148 and 151-153 under 35 U.S.C. §112, first paragraph because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The Examiner acknowledged that the specification is enabling for a method for obtaining a composition which comprises determining whether a chemical compound binds to a human Y4 receptor expressed on the surface of a mammalian cell transfected with

a vector adapted for expressing the receptor in the cell, wherein the chemical compound binds to a Y4 receptor encoded by the nucleotide sequence as set forth in SEQ ID NO: 1 or encoding the polypeptide of SEQ ID NO: 2 but alleged that the specification does not reasonably provide enablement for said methods using other Y4 receptors.

On page 8 of the November 21, 2003 Office Action, the Examiner rejected claims 147, 148, 151 and 153 for allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner alleged that the instant specification does not contain a written description of the invention in such full, clear, concise and exact terms or in sufficient detail that one skilled in the art can reasonably conclude that applicant was in possession of the claimed invention at the time of filing.

The Examiner alleged that the instant disclosure of one distinct polypeptide (i.e. SEQ ID NO: 2 encoded by SEQ ID NO: 1) does not adequately describe the scope of the use of the claimed genus. The Examiner alleged that the specification fails to provide sufficient descriptive information, such as definitive structural and functional features, or common attributes or characteristics that identify members of the claimed genus of polypeptides. The Examiner alleged that one of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe and enable the genus as broadly claimed.

In response, in an attempt to advance the prosecution but without conceding either the need for amendment or the correctness of the Examiner's position, applicants have amended claims 147, 148 and 153; and canceled claims 151 and 152. Accordingly, applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. §112, first paragraph.

Rejection Under 35 U.S.C. §102

On page 11 of the November 21, 2003 Office Action, the Examiner rejected claims 147, 148-151 and 153 under 35 U.S.C. §102(e) as anticipated by Gerald, et al. (US Patent No. 5,602,024). The Examiner alleged that Gerald, et al., has common inventors with the instant application and suggests that this rejection might be overcome either by a showing under 37 CFR §1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another", or by an appropriate showing under 37 CFR §1.131.

On page 11 of the November 21, 2003 Office Action, the Examiner suggested that this rejection might be overcome by a showing under 37 CFR §1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another". Applicants note that according to MPEP Section 2136.05 applicant may overcome a prima facie case by showing that the prior art patent is a disclosure of applicants' own previous work.

Jonathan A. Bard, et al.
Serial No.: 09/430,775
Filed: October 29, 1999
Page 17

Applicants maintain that the Declaration of Mary W. Walker Under 37 C.F.R. §1.132, a copy of which is attached hereto as **Exhibit B**, clearly establishes that the disclosure of the unclaimed Y4 invention present in U.S. Patent No. 5,602,024 is a disclosure of applicants' own work and that Christophe P.G. Gerald learned of applicants' Y4 invention from applicants.

Applicants further maintain that the Declaration Of Christophe P.G. Gerald Under 37 C.F.R. §1.132, a copy of which is attached hereto as **Exhibit C**, clearly establishes that Christophe P.G. Gerald did not conceive, or reduce to practice, the invention claimed in the above-identified application and that all disclosures concerning the Y4 receptor invention that were included in U.S. Patent No. 5,602,024 originated from one or more of his co-inventors, namely, Mary W. Walker, Theresa Brancheck and Richard L. Weinshank. Furthermore, Christophe P.G. Gerald disclaims being an inventor of any subject matter relating to the Y4 receptor that was included in U.S. Patent No. 5,602,024.

Applicants maintain that Gerald, et al. (U.S. Patent No. 5,602,024) should be withdrawn as a reference because Gerald, et al. is a disclosure of applicants' own work as established by the Declarations of Mary W. Walker and Christophe P.G. Gerald.

Accordingly, applicants respectfully request that this ground of rejection be withdrawn.